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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,315	02/09/2006	Ban Chin To	SCOTT USP4699	6117
27667 7590 07/21/2009 HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718				
EXAMINER MAKIYA, DAVID J				
ART UNIT 2885		PAPER NUMBER		
MAIL DATE 07/21/2009		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,315

Applicant(s)

TO, BAN CHIN

Examiner

David J. Makiya

Art Unit

2885

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment filed on 4/23/2009 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-42 and 49-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caluori (US Patent 5,609,414) in view of Houplain (US Patent 4,763,231) and Winkelhake (US Patent 5,868,493).

With respect to claims 34, 36, and 52-56, Caluori teaches a light fitting having a front and a rear, the light fitting having a support surround 12 and a front facia 24, and a facia retainer 26 for holding the front facia in position in the support surround (Column 3, Lines 19-21), the facia retainer being resilient for enabling removal (Figure 2) thereof from an installed position (Figure 1) thereof by a generally translational movement (Figure 1; Column 1, Lines 15-20), the light fitting further having a lamp retainer 24 and a lamp 2 wherein the lamp is retained by the lamp retainer (Figure 1), the front facia having a rear side and a front side (Figure 1), the facia to enable a finger or a tool to be engaged behind a ledge (overlap of 24 past 16; Figure 1) to facilitate removal of the front facia from the support surround (Column 3, Lines 11-21 and Column 5, Lines 13-15).

However, Caluori fails to teach the lamp being resiliently biased toward the rear side of the front facia such that the lamp may be moved backwards away from a recessed ledge of the rear side of the front facia or the front side of the facia being flush with a front surface of the support surround.

Houplain teaches a light fitting comprising a support surround 1 and a front facia 6 and a facia retainer 8, the facia retainer being resilient for enabling removal thereof from an installed position (Figure 5) at the front of the light fitting by a generally translational movement (Figure 2; Column 2, Lines 36-51), the light fitting further having a lamp retainer 17 and a lamp 11 wherein the lamp is retained by the lamp retainer (Column 2, Lines 60-64), the front facia has a rear side and a front side (Figure 2), and a tube 20 extending axially in front of the lamp (Column 3, Lines 5-15) the lamp being resiliently biased (15; Column 2, Lines 54-63) toward the rear side of the front facia such that the lamp may be moved backwards away from a recessed ledge 17 of the rear side of the front facia (Column 3, Lines 3-4) that engages the perimeter of the lamp (Figure 5) to enable a finger or a tool to be engaged behind the ledge to facilitate removal of the front facia from the support surround (Column 2, Lines 36-60), in which the resilient biasing is provided by two helical springs 15 for biasing the lamp towards the front facia (Column 2, Lines 54-63), each extending from an end 16 of a lamp opposite a lens end 24 thereof to a lamp retainer 16 and from an electrical connector (12, 13, 14) to the lamp retainer (Column 2, Lines 54-63).

Winkelhake teaches a light fitting having a front and a rear, the light fitting having a support surround (10b, 124) and a front facia (120, 122), and a facia retainer 118 for holding the front facia in position in the support surround, the light fitting further having a lamp retainer 16

and a lamp 17 wherein the lamp is retained by the lamp retainer, the front facia having a rear side and a front side, the front side of the facia being flush with a front surface of the support surround when in an installed position (Figure 5; Column 6, Lines 19-22).

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the light fitting of Caluori by adding helical springs to resiliently bias the lamp toward the front facia because they “makes it possible to hold the lighting fixture 11 together with the support 6 by means of two springs 1” (Houplain; Column 2, Lines 54-63) to ensure the electrical contact of the lamp to the socket 12 and by adjusting the shape of the facia such that the front side of the facia being flush with the front surface of the support surround from the teachings of Winkelhake because the facia would “mate with and support trim ring 124 serving to provide an aesthetic closure for open end 15 of housing 12” (Winkelhake; Column 6, Lines 19-22) and since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). It appears that the disclosed device would perform equally well shaped as disclosed by Caluori or Houplain.

With respect to claim 35, Caluori teaches the light fitting in which the lamp retainer forms the front facia (Figure 1).

With respect to claims 37-40, Caluori in view of Houplain and Winkelhake teaches the light fitting as described above.

However, Caluori in view of Houplain and Winkelhake fails to teach a particular shape for the front facia to have a non-circular cross section.

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the cross sectional shape of the front facia of Caluori in view of Houplain and Winkelhake with any shape, since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application *In re Dailey*, 149 USPQ 47 (CCPA 1976) and a simple substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. -, 82 USPQ2d 1385. It appears that the disclosed device would perform equally well shaped as disclosed by Caluori.

With respect to claim 41, Caluori teaches the light fitting in which the support surround includes at least one spring arm (40; Column 3, Lines 26-31) for holding the light fitting in place on a layer of building material 3.

With respect to claim 42, Caluori teaches the light fitting in which the front facia is directly retained by the facia retainer to the support surround (Column 3, Lines 19-21).

With respect to claim 49, Caluori teaches the light fitting in which the facia retainer comprises at least one spring clip (Column 3, Lines 19-21).

With respect to claim 50, Caluori teaches the light fitting in which a pair of said spring clips 40 is provided, located on opposed sides of the light fitting (Figure 1).

With respect to claim 51, Caluori teaches the light fitting in which each spring clip 26 is secured to the front facia (Figure 1; Column 3, Lines 19-21).

With respect to claim 57, Caluori teaches the light fitting which includes a lamp 92, the lamp having a flat front surface (Figure 1).

With respect to claim 58, Caluori teaches the light fitting which comprises a downlighter (Column 1, Lines 10-15).

Claims 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caluori in view of Houplain and Winkelhake as applied to claim 34, and further in view of Zadeh (US Patent 5,548,499).

With respect to claims 43 and 44, Caluori in view of Houplain and Winkelhake teaches the light fitting as described above.

However, Caluori in view of Houplain and Winkelhake fails to teach the front facia attached by the facia retainer to an intermediate member.

Zadeh teaches a light fitting having a front and a rear, the light fitting having a support surround 10 and a front facia 34, and a facia retainer 62 in which the front facia is attached by the facia retainer to an intermediate member 60, the intermediate member being pivotally connected to the support surround (Column 3, Lines 33-47).

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the light fitting of Caluori in view of Houplain and Winkelhake by adding the pivotally connected intermediate member from the teachings of Zadeh because "the lamp pivotally mounted so that its light may be directed at a plurality of angles relative to the ceiling" (Zadeh; Column 1, Lines 38-42).

With respect to claims 45-48, Caluori in view of Houplain, Winkelhake, and Zadeh teaches the light fitting as described above.

However, Caluori in view of Houplain, Winkelhake, and Zadeh fails to teach a particular shape for the front facia to have a non-circular cross section.

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the cross sectional shape of the front facia of Caluori in view of Houplain, Winkelhake, and Zadeh with any shape, since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application *In re Dailey*, 149 USPQ 47 (CCPA 1976) and a simple substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. -, 82 USPQ2d 1385. It appears that the disclosed device would perform equally well shaped as disclosed by Caluori.

Response to Arguments

Applicant's arguments with respect to claims 34-58 have been considered but are not convincing.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to the applicant's arguments regarding Caluori and Houplain not having the "front side of the facia being flush with a front surface of the support surround" as amended in independent claim 34, the applicant is referred to Figure 5 of the Winkelhake reference. There, it teaches the front side of the facia 122 being flush with a front surface of the support surround 124 when in an installed position (Figure 5; Column 6, Lines 19-22). Therefore, the reference meets the limitations as claimed. Furthermore, it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chan et al. (US Patent 4,274,615) teaches a light fitting with a front facia being flush with a support surround.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Makiya whose telephone number is (571) 272-2273. The examiner can normally be reached on Monday-Friday 7:30am - 4:00pm (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on (571) 272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hargobind S Sawhney/
Primary Examiner, Art Unit 2885

/DJM/ 07/16/2009